REMARKS

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

Request withdrawal of the Final Rejection

The Examiner has introduced new grounds for rejection not necessitated by an amendment made to the claims by applicants. Thus the final rejection is improper and applicants respectfully request that the finality of the rejection be withdrawn.. The two obviousness rejection should have been made by the Examiner in the first office action. They were not. Thus applicants respectfully believe that the finality of this rejection is improper.

Claim Rejections - 35 USC §112

Claims 92 and 93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action (OA) states "Claim 92 as written is dependent on itself and, consequently, is *prima facie* indefinite. Claim 93 is dependent on claim 92." The claims have been amended to correct this typographical error. IN view thereof withdrawal of this rejection is respectfully requested.

Claim Rejections - 35 USC §102

Claims 49, 81, 90, 91 and 96 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge et al (US 6,110,823) . Applicants respectfully disagree and request withdrawal or this rejection. Eldridge et al. is not prior art under 35 USC 102 as described below.

Claim Rejections - 35 USC §103

Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al (US 6,110,823) in view of Saruwatari et al (US 5,233,011). Applicants respectfully disagree and request withdrawal or this rejection. Eldridge et al. is not prior art under 35 USC as described below. The Examiner identifies no teaching in Saruwatari by which a dielectric coating can be formed on an elongated electrical conductor for which each of said first ends are bonded "to said surface so that said second ends are disposed away from said surface" and forming a dielectric coating on said elongated electrical conductors" bonded to said surface. Thus the Examiner has not made out a prima facie case of obviousness

Claims 86, 88 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al (US 6,110,823) in view of Nakata et al (US 5,665,610). Applicants respectfully disagree and request withdrawal or this rejection. Eldridge et al. is not prior art under 35 USC as described below.

Examiner's Response to Applicants' Arguments

The OA states

> Applicant's arguments filed April 3, 2006, have been fully considered but they are not persuasive. At page 21 of the response, applicant argues that Eldridge has no teaching of

any method of forming a dielectric coating on elongated conductors. As pointed out in the previous office action, such a teaching is found in figure 10K.. A layer of dielectric material (1094) is applied to flexible, elongated wire 1086 (column 67, lines 55-59).

Eldridge Col 67, lines 55-59, states:

A layer 1094 of dielectric material (such as silicon dioxide) is applied over the nickel layer 1092. The dielectric material (1094) may encompass (not shown) the contact pad 1088 to assist in anchoring the wire stem thereto.

Eldridge Col 67, lines 55-59, provides not teaching of how the dielectric material can be applied over the nickel layer 1092. Thus there is no enablement for this process and consequently no enablement for the structure of Eldridge figure 10k.

MPEP Section 2121.01 entitled "Use of Prior Art in Rejections Where Operability Is in Question " states

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema,* 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; **mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation.** *Elan Pharm., Inc. v. **>Mayo Found. For Med. Educ. & Research<*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) .... A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

Since Eldridge provides no description of how to make the structure of Eldridge Fig. 10k, it is insufficient "mere naming or description of the subject matter."

The Examiner has not shown " if the public was in possession of the claimed invention before the date of invention" by Applicants and thus the Examiner has not made out a prima facie showing that Eldridge is prior art under 35 USC 102. Applicants request that the Examiner

1. as required by 37 CFR 104(d)(2) provide documentary evidence that a person of ordinary skill in the art was in possession of haw to practice the mere description of Eldridge Col 67, lines 55-59, without relying on Applicants' invention., or

2. as required by 37 CFR 104(d)(2) , in the absence of providing g such documentary evidence, to provide and Examiner's affidavit qualifying the Examiner has having sufficient expertise to provide how to practice the mere description of Eldridge Col 67, lines 55-59, without relying on Applicants' invention., or

3. withdraw all the prior art rejections since the Examiner has not made out a prima facie showing that Eldridge is prior art under 35 USC 102 to applicants invention..

In view of the remarks herein, the Examiner is respectfully requested to reconsider the above-identified application. If the Examiner wishes to discuss the application further, or if additional information would be required, the undersigned will cooperate fully to assist in the prosecution of this application.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

If the above-identified Examiner's Action is a final Action, and if the above-identified application will be abandoned without further action by applicants, applicants file a Notice of Appeal to the Board of Appeals and Interferences appealing the final rejection of the claims in the above-identified Examiner's Action. Please charge deposit account 09-0468 any fee necessary to enter such Notice of Appeal.

In the event that this amendment does not result in allowance of all such claims, the undersigned attorney respectfully requests a telephone interview at the Examiner's earliest convenience.

MPEP 713.01 states in part as follows:

> Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner,... the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

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